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Message

DOCKET No. : 50N3787

Please see attached:                      Response to Notification of Non-Compliant Appeal Brief

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

JUN 26 2006

Applicant: Brian M. Siegel et al.  
Serial No.: 09/745,669  
Conf. No.: 5754  
Filed: December 21, 2000  
Title: Method And System For Performing Electronic Retailing  
Art Unit: 3625  
Examiner: Jeffrey A. Smith  
Docket No.: 50N3787  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

**RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF**

In response to the Notification of Non-Compliant Appeal Brief, dated May 24, 2006, Appellant hereby submits the following Appeal Brief, addressing the issue raised in the Notification. The time for response to the Notification is extended to Monday, June 26, 2006.

**PETITION UNDER 37 CFR 1.136(a)  
AND APPEAL BRIEF UNDER 37 C.F.R. §41.31**


Sir:

As set forth in the Notice of Appeal filed January 23, 2006 and received by the U.S. Patent Office on January 24, 2006, Appellant hereby appeals the final decision of the Examiner in the above-identified application rejecting the subject matter of the pending claims.

**Certificate of Facsimile Transmission**

I hereby certify that this document and any document referenced herein has been transmitted via facsimile to the US Patent and Trademark Office at (571) 273-8300 on  
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Karin L. Williams, Reg. No. 36,721  
(Printed Name of Person Mailing Correspondence)

  
(Signature)

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Appellant respectfully requests that the Board of Patent Appeals and Interferences reverse the Examiner's rejection of the claimed subject matter. Appellant hereby petitions the Assistant Commissioner to grant a one (1) month extension of time, up to and including April 24, 2006, in which to file this Appeal Brief. The extension fee may be charged to deposit account No. 50-1047. In addition, any deficiencies may be charged to deposit account No. 50-1047.

### **I. REAL PARTY IN INTEREST**

Sony Corporation and Sony Electronics Inc. are the assignees of the present invention and the real parties in interest.

### **II. RELATED APPEALS AND INTERFERENCES**

No other appeals or interferences are known to Appellant, Appellant's legal representative, or the assignees, which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

### **III. STATUS OF CLAIMS**

This application was filed with Claims 1-41.

A first Office Action mailed on November 6, 2003 rejected all of Claims 1-41 as being anticipated by, or unpatentable over, US Patent 6,587,835 (Treyz et al.).

A first Amendment in response to the November 6, 2003 Office Action was filed on Monday, March 8, 2004 - in that Amendment, Claims 8-16, 25-27, 29-30 and 33-41 were canceled and independent Claim 28 was amended.

A second, non-final Office Action mailed on May 21, 2004 rejected Claims 1-7, 28, 31 and 32 as being unpatentable over newly-cited article "Swipe your Shopping" (Field, Chris, March 11, 1998, The Times) in view of US Patent 5, 047,614 (Bianco), and Claims 17-24 were rejected as being unpatentable over Qode ([www.qode.com](http://www.qode.com)), the article "Get Ready to Pocket a Personal E-shopper" (Joshi, Pradnya, Oct. 22, 2000, South Florida Sun - Sentinel) and the QRS

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Press Release "Qode Teams with QRS to Give On-line Retailers Advanced Marketing Capabilities, dated Oct. 3, 2000".

A second Amendment in response to the May 21, 2004 Office Action was filed on August 23, 2004 – in that Amendment, Claims 17-24 were canceled.

A third, non-final Office Action mailed on November 2, 2004 rejected Claims 1, 7 and 28 as being anticipated by newly-cited US Patent 5,774,874 (Veeneman), Claims 3 and 5 as being unpatentable over Veeneman in view of the Field article, and Claims 31-32 as being unpatentable over Veeneman in view of newly-cited US Patent 6,181,326 (Takahashi).

A third Amendment in response to the November 2, 2004 Office Action was filed on Monday, April 4, 2005 – in that Amendment, Claims 2-4 were canceled and Claims 1, 5, 7 and 28 were amended.

A fourth, non-final Office Action mailed on July 14, 2005 rejected Claims 1 and 7 under 35 USC 112, first and second paragraphs, and Claims 1, 5-7, 28 and 31-32 as being anticipated by newly-cited US Patent 6,448,979 (Schena) in view of newly-cited US Patent 6,652,455 (Kocher).

A fourth Amendment in response to the November 2, 2004 Office Action was filed on October 14, 2005 – in that Amendment, Claims 1 and 7 were amended.

A Final Office Action was mailed on January 10, 2006. There were no amendments after the Final rejection.

Claims 1, 5-7, 28 and 31-32 are now pending and stand finally rejected. Claims 1, 7 and 28 are the only independent claims. The rejection of each of the pending claims is appealed. The pending claims are set for in the Claims Appendix in Section VIII of this Brief.

#### **IV. STATUS OF AMENDMENTS**

A Final Office Action was mailed on January 10, 2006, finally rejecting Claims 1, 5-7, 28 and 31-32. A Notice of Appeal was filed on January 23, 2006, and received by the US Patent Office on January 24, 2006. As noted above, there were no amendments filed subsequent to the Final Office Action.

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## V. SUMMARY OF CLAIMED SUBJECT MATTER

The application describes an apparatus for retrieving information related to a consumer product using a consumer product codes including a portable consumer good that lacks the capacity for data transmission (lines 1-7, para. [0034]), wherein the portable consumer good comprises a non-electronic device (lines 1-7, para. [0034]), and a scanning and storage device incorporated into the portable consumer good (lines 7-8 of para. [0029], FIG. 1, para. [0034]), the scanning and storage device including a scanning element converting a product code symbol into machine readable information representative of the product code (lines 1-3 para. [0028]) and a removable memory medium to which the information is stored (para. [0039] – [0040]). A further embodiment includes an Internet-ready device couplable to one or more Internet-based information servers (lines 2-3 of para. [0035], para. [0036], para. [0041], para. [0042]), said Internet-ready device including a removable memory medium (lines 4-5 para. [0043], para [0044] - [0047]) adapted to accept said removable memory medium from said scanning and storage device (lines 6-7 para. [0040], FIGs. 3 and 4).

A method is also described, for retrieving information related to a consumer product comprising the steps of integrating a bar code scanner and a removable memory into a consumer good, wherein the consumer good comprises a non-electronic device (para. [0029] and [0034]), scanning a bar code of a selected consumer product using the integrated scanner and storing the scanned bar code in the removable memory (para. [0028], [0039] and [0040]), transferring the scanned bar code from the removable memory to a computer network (para. [0040]) and accessing a web site on a computer network based on the scanned bar code (para. [0041]), wherein the web site includes information related to the selected consumer product (para. [0043], para. [0044], and FIG. 3).

## VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Appellant presents the following issue for review:

Would the subject matter of the appealed claims (Claims 1, 5-7, 28 and 31-32) have been obvious to one of ordinary skill in the art at the time the invention was made from the combined disclosures of US Patent 6,448,979 (Schena) and US Patent 6,652,455 (Kocher).

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## VII. ARGUMENT

The Appellant respectfully submits that the rejection of Claims 1, 5-7, 28 and 31-32, is erroneous for the following reasons. Claims 1, 7 and 28 are independent; Claims 5 and 6 depend upon independent Claim 1; Claims 31-32 depend upon independent Claim 28.

Independent Claim 1 is directed an apparatus for retrieving information related to a consumer product using a consumer product codes. The apparatus includes a portable consumer good that lacks the capacity for data transmission, wherein said portable consumer good comprises a non-electronic device and a scanning and storage device incorporated into the portable consumer good. The scanning and storage device includes a scanning element converting a product code symbol into machine readable information representative of said product code and a removable memory medium to which the information is stored.

The apparatus of independent Claim 7 includes all of the elements recited in independent Claim 1 and also recites an Internet-ready device couplable to one or more Internet-based information servers, the Internet-ready device including a removable memory medium adapted to accept the removable memory medium from the scanning and storage device.

Claim 28 is directed to a method for retrieving information related to a consumer product comprising the steps of: integrating a bar code scanner and a removable memory into a consumer good, wherein the consumer good comprises a non-electronic device, scanning a bar code of a selected consumer product using the integrated scanner and storing the scanned bar code in the removable memory, transferring the scanned bar code from the removable memory to a computer network, and accessing a web site on a computer network based on the scanned bar code, wherein the web site includes information related to the selected consumer product.

The Final Office Action recites that "Schena teaches a method for retrieving information related to a consumer product", including integrating a bar code scanner and removable memory into a consumer good, that is a non-electronic device, scanning a bar code of a selected consumer product using the integrated scanner and storing the bar code, transferring the scanned bar code to a computer network, and accessing a website on the computer network based on the scanned

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bar code (the Action directs Applicant to “at least col. 3, lines 42-63, Col. 4, lines 32-37, Col. 5, lines 34-39 and Col. 6, lines 27-36”).

The Final Office Action takes the position that “while Schena does disclose storing the scanned bar code/data in an enhanced device such as a key chain or smart card in which the scanner is incorporated/integrated, the reference *does not specifically disclose* and teach a removable memory”.

The Final Office Action then turns to the alleged teachings of Kocher, stating that “Kocher teaches storing the data in a removable memory (Col. 5, lines 27-30)” (the previous non-final Action, in relying upon Kocher, stated that “in the same area of storing data in scanning device, [Kocher] teaches storing the data in a removable memory” – and that “one of ordinary skill in the art would have been motivated to extend the method and apparatus of Schena with a method and apparatus for storing the data in a removable memory of a scanner”).

The conclusion is then made in the Final Office Action that “it would have been obvious...to have provided the apparatus and method of Schena with the apparatus and method of Kocher to meet the claimed limitations of claim 28”. The Action further notes (top of page 4) that “one of ordinary skill in the art would have been motivated to extend the method and apparatus of Schena with a method and apparatus for storing data in a removable memory of a scanner”, “*in order to provide an old and well known option*”.

Applicant submits that Schena is directed to a device for “using scanner technology to bridge the gap between printed media and the virtual world of interactivity and the Internet” (col. 1, lines 52-54). Schena very specifically requires a device that “sends link information and the user input information via the network, *a receiver in communication with the scanner*, capable of receiving the link information and user input information...” (Abst). Schena does *not* teach or suggest, nor would one of ordinary skill in the art be motivated (in light of the teachings of Kocher at least), to modify Schena to include a *removable memory device*. In this regard, Schena specifically recites that “the scanner 100 generates and stores a code file in memory...uploads the coded file in memory 110 to the receiver 180” (col. 5, lines 37-39) -- “scanner 100 can transmit the code 10 to a receiver 180, such as a television...or directly to the portal server 200” (col. 6, lines 27-31) – “communications bridge 130 sends the link information...to the receiver 180 and, via the network, to the portal server 200 (col. 7, lines 14-16) – “scanner 100 may access the

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portal server via a telephone dial system...a user may use a telephone to communicate the scanner 100 to the network" (col. 9, lines 30-33).

Kocher, relied upon for teaching a removable memory device, is directed to a device specifically designed "for scanning" – unlike Applicants' claimed invention that recites a portable consumer good that *lacks the capacity for data transmission and comprises a non-electronic device* -- and that has a scanning a storage device *incorporated therein*.

The "removable memory module 22" of Kocher "can include barcode numbers and other related information such as the name, product, suggested serving size, nutrients and chemicals included in the product, and processing techniques that may have an incidence on the individual's health" (col. 5, lines 30-34). The removable memory module of Kocher does not however, store information that is created from the product code symbol that is scanned -- but rather, "using the scanned information, the processor 10 performs an automatic search in the database 22, to retrieve the information *pertaining to the product scanned*" (col. 6, lines 62-65 of Kocher).

In addition, while Kocher does note that "product information is stored in databases on one or more removable memory modules 22" (col. 5, lines 26-29) – Kocher does *not teach or suggest storing scanned information* in a removable memory medium, *wherein the removable memory medium may be removed therefrom and inserted into an internet-ready device*.

Rather, while Kocher includes removable memory modules 22 to store information "pertaining to" products scanned, he very specifically notes that the "while the device and a remote computer *can be hardwired* in a conventional manner, such as transferring data by telephone lines, the invention also contemplates *using a wireless connection*" (Col. 5, lines 13-17). Kocher further notes that "an interface 20, such as a *serial or parallel port or infrared or other wireless transmitter*, is used to exchange data between this device and an external device, for the purpose of updating both databases or for transferring recorded data, personal data, and settings to a remote location" (Col. 6, lines 10-15).

There is absolutely no teaching or suggestion in either Schena (as acknowledged in the Action), *or Kocher*, of a removable memory medium (for storing machine readable information representative of a scanned product code symbol) in a portable consumer good that lacks the



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capacity for data transmission that can be removed from the portable consumer good and inserted into an internet ready device.

Of course to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation *to make the necessary modification of the teaching of the references combined to result in the pending claims*. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. MPEP §§2142-2143; *In re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1943-44 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q. 1596, 1598-99 (Fed. Cir. 1988). The teaching or suggestion to make the claimed *modification* and the reasonable expectation of success *must both be found in the prior art and not based on applicant's disclosure*. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). 706.02(j) [emphasis supplied].

Thus, Appellant respectfully submits that Claims 1, 5-7, 28 and 31-32 of the present invention are not taught or suggested by Schena and Kocher and would not be obvious in light of any combination of Schena and Kocher.

Appellant further respectfully submits that it is, of course, improper to pick and choose elements from several references in order to "build" an obviousness rejection, when such a combination would not in fact have been obvious to one of ordinary skill in the art. One of ordinary skill in the art would not have even considered turning to the alleged teachings of Kocher to "provide an old and well known option", without the teachings provided by Appellant's disclosure – which, of course, is not a proper basis for rejection, as it is impermissible to use an Applicants' specification as an instruction manual or "road map" to piece together the teachings of the prior art in order to render claims obvious. *Akzo N.V. v. U.S. International Trade Commission*, 808 F.2d 1471, 1 U.S.P.Q.2d 1241 (Fed. Cir. 1986), *cert. denied*, 482 U.S. 909 (1987). Since there is *no teaching* in these references that would suggest each of the elements recited in the present claims, even if one used impermissible hindsight and combined the teachings of the references, the present invention would not be achieved.

Accordingly, Appellants respectfully submit that independent Claims 1, 7 and 28, and dependent Claims 5-6 and 31-32, of the present invention are not taught or suggested by Schena

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and Kocher, and would not be obvious in light of any combination of the teachings of Schena and Kocher.

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### VIII. CLAIMS APPENDIX

The claims involved in the appeal, Claims 1, 5-7, 28 and 31-32, are reproduced below.

1. (Previously Presented) An apparatus for retrieving information related to a consumer product using a consumer product codes comprising:
- a) a portable consumer good that lacks the capacity for data transmission, wherein said portable consumer good comprises a non-electronic device; and
  - b) a scanning and storage device incorporated into said portable consumer good, said scanning and storage device including:
    - (i) a scanning element converting a product code symbol into machine readable information representative of said product code; and
    - (ii) a removable memory medium to which said information is stored.
- 2-4. (Canceled)
5. (Original) The apparatus according to claim 1, wherein said non-electronic device comprises one of the following: an article of clothing, a pen and a pocketbook.
6. (Original) The apparatus according to claim 1, wherein said removable memory medium comprises one of the following: a magnetic disc, flash memory, a smart card, a memory stick, a diskette, a CD-ROM, a disk drive, a random access memory chip, and an optical storage device.

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7. (Previously Presented) An apparatus for retrieving and processing information related to a consumer product using a universal product code comprising:
- a) a portable consumer device, said portable consumer device including:
    - (i) a portable consumer good comprising a non-electronic device that lacks the capacity for data transmission; and
    - (ii) a scanning and storage device incorporated into said portable consumer good, said scanning and storage device comprising:
      - (1) a scanning element converting a printed universal product code symbol into machine readable information representative of said universal product code; and
      - (2) a removable memory medium to which said information is stored; and
  - b) an Internet-ready device couplable to one or more Internet-based information servers, said Internet-ready device including a removable memory medium adapted to accept said removable memory medium from said scanning and storage device.

8-27. (Canceled)

28. (Previously Presented) A method for retrieving information related to a consumer product comprising the steps of:
- integrating a bar code scanner and a removable memory into a consumer good, wherein said consumer good comprises a non-electronic device;
  - scanning a bar code of a selected consumer product using the integrated scanner and storing the scanned bar code in the removable memory;
  - transferring the scanned bar code from the removable memory to a computer network; and
  - accessing a web site on a computer network based on the scanned bar code, wherein said web site includes information related to the selected consumer product.

29-30. (Canceled)

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31. (Original) The method according to claim 28, further comprising converting a scanned bar code to a uniform resource locator (URI) of a web site.

32. (Original) The method according to claim 28, further comprising converting a scanned bar code and a global position to a uniform resource locator (URI) of a web site.

33-41. (Canceled)

### CONCLUSION

The references relied upon by the Examiner do not support a *prima facie* case of obviousness. Appellant submits that the pending claims, Claims 1, 5-7, 28 and 31-32 are patentable over the art of record and it is respectfully requested that the Board reverse the final rejection of the subject matter of these claims for the reasons given above.

Respectfully submitted,

  
Karin L. Williams Registration No. 36,721

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